

REMARKS

Claims 1-12, 14, 15 and 18-21 are pending in this application. Claims 1-11 are withdrawn from consideration as being drawn to a non-elected Group. Rejoinder of claims 1-12, 14, 15 and 18-21 is respectfully requested.

By this Amendment, claims 12 and 21 are amended. Claim 12 is amended to recite features supported in the specification on page 22, line 3 – page 23, line 13 and Fig. 4. No new matter is added by any of these amendments.

Reconsideration based on the following remarks is respectfully requested.

I. Claim 21 Satisfies the Requirements under 35 U.S.C. §112, second paragraph

The Office Action rejects claim 21 under 35 U.S.C. §112, second paragraph, as being indefinite. Claim 21 has been amended to obviate this rejection in view of the Examiner's helpful comments. Withdrawal of the rejection under 35 U.S.C. §112, second paragraph is respectfully requested.

II. Claims 12, 14, 15 and 18-21 Define Patentable Subject Matter

The Office Action rejects claims 12, 14, 15 and 20 under 35 U.S.C. §103(a) over Japanese Patent JP 2726856 B2 to Kondo *et al.* (Kondo) in view of U.S. Patent 5,620,544 to Cram *et al.* (Cram). This rejection is respectfully traversed.

Applicants assert that Kondo and Cram, either alone or in combination, fail to teach or suggest a process for producing a roll including, *inter alia*, extending a wide main film along a running direction perpendicular to a width of the wide main film; printing a desired item on a first surface of an adhesive film, the adhesive film having adhesive on a second surface; adhering the adhesive film by the second surface onto a third surface of the main film while extending the adhesive film along the running direction, as recited in claim 12.

Instead, Kondo discloses an apparatus for manufacturing ink ribbon rolls. In particular, Kondo teaches unwinding a master roll **R** along the length of the **R** tape, manually

attaching a leader tape **t** from a master lead roll **T** perpendicular to the **R** tape. Subsequently, the **R** tape is cut into strips **r** and wound around a mandrel core 4. See pages 3-5 and Fig. 1 of Kondo. There is no teaching in Kondo for printing information on the leader roll **T**. Further, by running leader **t** perpendicular to the **R** tape running direction, Kondo teaches away from Applicants' claimed features.

In addition, Cram discloses a coreless tape roll 15. In particular, Cram teaches the roll 15 having an innermost wrap 72 at the leading edge 71 to form a liner 73, and a tab portion 75 at the outermost edge 74. Cram also teaches indicia 77 on the tab portion 75. See col. 6, lines 39-61 and Fig. 2 of Cram. There is no teaching or suggestion in Cram of cutting the tape across its width, nor any motivation to combine such a feature from Kondo. Nor does Cram provide adhesive tape running along the running direction of the wide main tape.

Further, there is no motivation to combine features related to [referenced feature] of Kondo with [referenced feature] of Cram, nor has the Office Action established sufficient motivation or a *prima facie* case of obviousness. Even assuming that motivation to combine the applied references is established, the combination fails to teach or suggest Applicants' claimed features.

The Office Action further rejects claims 12, 14, 15 and 18-21 under 35 U.S.C. §103(a) over U.S. Patent 4,339,294 to Jones in view of Cram. This rejection is respectfully traversed.

Jones and Cram do not teach or suggest a process for producing a roll including, *inter alia*, extending a wide main film along a running direction perpendicular to a width of the wide main film; printing a desired item on a first surface of an adhesive film, the adhesive film having adhesive on a second surface; adhering the adhesive film by the second surface onto a third surface of the main film while extending the adhesive film along the running direction, as recited in claim 12.

Instead, Jones discloses a method of preparing reed strip material, with a strip 9 applied to a web (tape) 1. In particular, Jones teaches punching holes 5a, 5b through a web (tape) 1, with a strip 9 applied to the web 1, which is then cut across its width. See col. 3, lines 5-14, 60-63 and Fig. 1 of Jones. Thus, in similar fashion to Kondo, Jones teaches applying a strip 9 perpendicular to the running direction of the web 1, and thereby teaches away from Applicants' claimed features.

Cram does not compensate for the deficiencies of Jones. Instead, as discussed *infra*, Cram discloses a coreless tape roll 15 with no suggestion of cutting the tape across its width. Further, there is no motivation to combine features related to strip maker of Jones with the coreless tape roll of Cram, nor has the Office Action established sufficient motivation or a *prima facie* case of obviousness. Even assuming that motivation to combine the applied references is established, the combination fails to teach or suggest Applicants' claimed features.

A *prima facie* case of obviousness for a §103 rejection requires satisfaction of three basic criteria: there must be some suggestion or motivation either in the references or knowledge generally available to modify the references or combine reference teachings, a reasonable expectation of success, and the references must teach or suggest all the claim limitations. See MPEP §706.02(j). Applicants respectfully assert that the Office Action has not satisfied this burden, either with the combination of Kondo and Cram or with the combination of Jones and Cram.

For at least these reasons, Applicants respectfully assert that the independent claim is now patentable over the applied references. The dependent claims are likewise patentable over the applied references for at least the reasons discussed as well as for the additional features they recite. Consequently, all the claims are in condition for allowance. Thus, Applicants respectfully request that the rejections under 35 U.S.C. §103 be withdrawn.

III. Conclusion

In view of the foregoing amendments and remarks, Applicants respectfully submit that this application is in condition for allowance. Favorable reconsideration and prompt allowance are earnestly solicited.

Should the Examiner believe that anything further is desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact Applicants' undersigned representative at the telephone number listed below.

Respectfully submitted,



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